

Remarks

Claims 1-3, 6-12, 18-22 and 30-32 were rejected under 35 USC 103(a) as being unpatentable over US Patent 5,814,579 to Dotson et al (hereinafter the '579 patent). Claims 16-17 and 47 were rejected as being unpatentable over the '579 patent in view of US Patent 6,062,604 to Taylor et al (hereinafter the '604 patent). Claim 23 was rejected as being unpatentable over the '579 patent in view of US Patent 5,932,870 to Berson (hereinafter the '870 patent). Claims 15 and 23 were rejected as being unpatentable over the '579 patent in view of US Patent 5,883,043 to Halbrook, Jr. et al (hereinafter the '043 patent). Claims 4-5, 24-29, 33-46 and 48-49 were rejected as being unpatentable over the '579 patent in view of US Patent 5,591,527 to Lu (hereinafter the '527 patent).

By this response, claims 1, 2, 33, 34, 36, 38, 43 and 44 have been amended, while new claims 60 through 63 have been added. Claims 50 through 59 were withdrawn by an earlier election. No new matter was added by these amendments. Support for the new claims comes from the original specification at page 7, lines 19 through 23, wherein the Applicants noted that "[i]t will be appreciated that the locations where notorious indicia 6, 7 show up in FIG. 1 are for illustrative purposes only, and that the security features discussed in conjunction with the present invention could be applied to any or all parts of form 2, specifically to the areas defined by the security document 1." Such verbiage clearly contemplates the superposition of one security feature on top on another. Further support comes from original FIGS. 3 and 4 that show a superimposed (overlapping) relationship between the first and second coatings. By virtue of such overlapping, the coatings contain a common area on the substrate with which to project more than one notorious indicia of tampering.

The amended independent claims recite that different notorious indicia are produced in each of the security coatings. By contrast, the device depicted in the '579 patent shows a single layer design that does not distinguish between solvent-sensitive and abrasion-sensitive features, stating at column 1, lines 22 through 23 that a single latent image "becomes visible upon application of pressure or solvent. . . ." As such, it is impossible for the device of the '579 patent

to produce the claimed indicia, as its single layer is only capable of rendering a single image, while the claimed device can produce two distinct images. "To establish a *prima facie* case of obviousness, three basic criteria must be met." MPEP 2143. One of the requirements is that all of the claim limitations must be taught or suggested. MPEP 2143.03. There is nothing in the '579 patent that teaches or suggests a security document with multiple coating layers, each producing its own indicia of tampering. Moreover, there is no teaching in any of the secondary references cited by the Examiner to even remotely suggest the desirability of incorporating a second security coating to display a second indicia of tampering. Since at least this portion of the tripartite test for obviousness is not satisfied, a *prima facie* case cannot be made out, and the present rejection cannot be sustained.

Another of the requirements for the establishment of a *prima facie* case of obviousness is that the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. MPEP 2143.01. The mere fact that the prior art could be modified as proposed by the Examiner is not sufficient to establish a *prima facie* case, as the Examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification.. *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In the present Office Action, the Examiner takes the position that it would have been obvious to duplicate the coating later of the '579 patent to produce the claimed multilayer device, citing *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (CA 7 1977). The amended claims make it clear that such a position cannot be maintained, as the separate indicia-bearing layers of coatings of the claimed device include capabilities inconsistent with the scope of the '579 patent. Specifically, by providing a separate abrasion-sensitive coating, the claimed device is consciously exploiting that which the device of the '579 patent seeks to minimize: the inadvertent and premature development of a latent image by methods other than solvent-based. Evidence of such abounds in the '579 patent, for while the Examiner is correct in noting that latent image coatings that are both abrasion and solvent sensitive are discussed in the '579 patent, a closer reading indicates that the abrasion sensitivity is a feature to be avoided rather than exploited. For example, at column 1, lines 30 through 33, the '579 patent discusses the "inadvertent" and "unintended" revealing of the latent image that can occur through handling (a common source of abrasion). In

addition, the device of the '579 patent relies upon a solvent-containing imaging device 12 (shown in FIG. 1) that includes a soft felt tip 16 with which to deposit a solvent for bringing the latent image into view.

Taken *in toto*, it is clear that at the very least, the '579 patent does not teach or suggest the desirability of providing a separate coating layer to accommodate abrasion-sensitive indicia. In fact, considering the entirety of the teaching of the '579 patent, with its emphasis on minimizing the effects of the coating's inherent abrasion-sensitive features, it is more likely that the intent of the '579 patent is to teach away from the claimed invention's express employment of an abrasion-sensitive coating layer. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983). The antithesis of such motivation occurs when the reference(s) teach away from each other or the claimed invention; such a teaching away is a *per se* demonstration of lack of *prima facie* obviousness. See, e.g., *In re Dow Chemical Co.*, 5 USPQ2d 1529 (Fed. Cir. 1988).

Accordingly, the Applicants respectfully submit that the amended independent claims 1, 33 and 43 preclude the Examiner from satisfying at least two prongs of the tripartite test for obviousness, and as such is prevented from asserting that the claims are unpatentable over the art of record. Accordingly, the Applicants believe that all of the independent claims 1, 33 and 43 are in condition for allowance. The remaining claims, being dependent upon their respective independent claims, present additional features that further distinguish over the cited art. As such, the Applicants submit that all of the dependent claims are also allowable.

Conclusion

The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, notification of allowable subject matter is respectfully solicited.

Respectfully submitted,
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